

Docket 83010/TJS
Customer No. 01333

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Dale F. McIntyre, et al

**SYSTEM AND METHOD FOR
MANAGING IMAGES OVER A
COMMUNICATION NETWORK**

Serial No. 09/891,474

Filed June 26, 2001

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Group Art Unit: 2154
Confirmation No. 9394
Examiner: Joshua Joo

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Carol J. Murphy
Carol J. Murphy
November 18, 2005
Date

Sir:

APPEAL BRIEF TRANSMITTAL

Enclosed herewith is Appellants' Amended Appeal Brief for the above-identified application that is sent in response to the Notification of Non-Compliant Appeal Brief, dated October 19, 2005. We have complied with the Examiner's request.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.



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APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134

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APPELLANT'S BRIEF ON APPEAL

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1-15 which was contained in the Office Action mailed March 24, 2005.

A timely Notice of Appeal was mailed on May 26, 2005 which was received in the USPTO on May 31, 2005.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1-15 are pending in the application. These claims have been rejected and are being appealed.

Appendix I provides a clean, double spaced copy of the claims on appeal.

Status Of Amendments

The claims stand as indicated in Appendix I.

Summary of Claimed Subject Matter

The present invention is directed to method and system for managing digital images. *See* page 3, lines 25-26. In particular, the invention is directed to a device for creating an electronic icon, which contains information unique to a particular user. *See* page 20, lines 16-23; pages 9-10; Figs. 10a-10b. The icon allows access with respect to a digital media file over a communication network by a third party. *See* page 9, lines 7-24; Figs. 1 and 10a-10b. The icon then allows a third party who is associated with the icon to access the image on a

computer in which the digital image and associated icon are stored. *See* page 10, lines 17-18; page 9, lines 7-24; claims 1 and 11. The device for creating an electronic icon includes a user computer and the digital media file is stored in a memory device in the computer. *See* page 20, lines 16-23; Figs. 10a-10b; claim 2. An example of its implementation is in a digital camera that captures an image and a unique icon is associated with the captured image. *See* page 30, line 13 – page 32, line 23; Fig. 21; claim 3. Further, the electric camera has a communication device for transferring the digital media file to a service provider in which the electronic icon includes instructions, which includes automatically forwarding of the digital image file to a third party, for further processing of the digital image file. *See* page 32, lines 7-18; page 9, line 7 – page 10, line 24; claims 5 and 8. The service provider provides confirmation of receipt of said digital media file to said electronic camera. *See* page 24, lines 11-19; claims 6. The service provider also accesses the computer over the communication network to locate digital media files having said icon associated therewith and allowing access to said digital media files by said designated third party. *See* page 10, lines 2-10; page 9, lines 7-24; claims 11.

Grounds of Rejection to be Reviewed on Appeal

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether claims 1 and 4 are obvious under 35 USC § 103(a) over Jalili (U.S. Patent 6,209,104) and Savitzky et al. (U.S. Patent 6,571,271).
2. Whether claim 2 is obvious under 35 USC § 103(a) over Jalili, Savitzky and in view of Hoyle (U.S. Patent 6,771,290).
3. Whether claims 3, 5 and 6 are obvious under 35 USC § 103(a) as being unpatentable over Jalili, Savitzky and in view of Tomat et al. (U.S. Patent 6,784,925).

4. Whether claim 8 is obvious under 35 USC § 103(a) as being unpatentable over Jalili, Savitzky, Tomat and in view of Reed et al. (U.S. Patent 6,044,205).

5. Whether claims 11 and 12 are obvious under 35 USC § 103(a) as being unpatentable over Jalili, Savitzky, Hoyle and Morris.

6. Whether claim 15 is obvious under 35 USC § (103(a) as being unpatentable over Jalili, Savitzky, Hoyle, Morris, Reed and in view of Tomat.

Arguments

The Rejection

A. Rejection of claim 1 under 35 USC § 103(a)

Applicant respectfully submits that the Jalili and Savitzky references fail to teach or suggest the invention as taught and claimed by Applicant. In claim 1 of the present invention, the icon is unique to a particular individual user. The unique icon, as set forth in independent claim 1, allows access with respect to a particular media file associated with the icon over a communication network by a third party. The unique icon in the present invention is used to identify specific images and associated specific instruction with regard to the identified image for controlling authorized access thereto. This is in complete contrast to the icons of Jalili that are displayed on a screen. The icons that are displayed on the screen of Jalili are not unique or specific to a particular user, they are used to allow the person at the display to enter a specific code to allow access to the particular database. It is the particular code that allows access to the database. The icons of Jalili are simply used to allow entry of a specific code. As set forth at column 2, lines 1-3 of the Jalili reference, the icons disclosed therein are directed to solving a problem of other individuals observing the direct keyboard entry of passwords and other data which is susceptible to other ready observation by a third party. As further set forth in Jalili at column 6, lines 33-37, the server sub-system generates a display image 250 (see FIG. 4), which bearing a group of icons pseudorandomly arranged, arrayed or otherwise presented on the display device 104. As further set

forth at column 8, lines 25-32 of Jalili, there is discussion of the pseudorandom location of these icons. The user uses the location of the icons for entering of the appropriate code. Thus, the Jalili reference is not associating a unique icon with particular images, but uses icons for creating a method for allowing entry of a unique code by a third party. The Jalili reference is directed to providing restricted access and prevent a unique way of entering a code through the use of icons that are pseudorandomly displayed on a screen.

In the present invention the icons are unique to a particular user that allows access for that user to that particular media file. There is no such teaching or suggestion in Jalili of providing such.

In the present invention of claim 1, it is the individual that creates the icon. In the Jalili reference the server displays a plurality of stored icons from which a user may use for providing entry of a password. As previously discussed the icons of Jalili are designed to restrict access to a particular user. In the present invention the initial user allows access to a media file by an authorized third party by associating the icon with the media file. The information that is associated with the icon provides instruction for allowing of the access.

The Savitzky reference, cited in combination with the Jalili reference, is directed simply to detecting images on a storage device and downloading images and thereby later providing them to an HTML page that is generated by the image server. There is no teaching or suggestion of creating an icon that contains information unique to a particular user that allows access with respect to the particular media file by a third party over a communication network as claimed by Applicant. The cited passage at column 8, lines 26-30 of Savitzky merely describe different mathematical patterns that are used for providing the code into the computer. There is no teaching or suggestion of providing an icon that is associated with a particular user as taught and claimed by Applicant.

Applicant respectfully submits that neither Jalili nor Savitzky, individually or in combination, suggest creating an electronic icon unique to a particular user that includes information allowing access with respect to the particular digital media file having the icon and associated therewith over a communication network by a third party.

B. The rejection of claim 2 under 35 USC § 103(a)

Claim 2 is dependent upon independent claim 1 and includes the additional limitation that the device for creating the electronic icon comprises a user computer and the digital media file is stored in the memory of the computer. The Examiner cites the additional reference of Hoyle for rendering claim 2, in combination with Jalili and Savitzky, unpatentable. The Examiner states in paragraphs 11 and 12 of the Final Office Action that Hoyle teaches an invention for using links or shortcuts to access files stored on the computer and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Jalili and Hoyle because they both deal with using an image object as means to access files. Hoyle does not teach or suggest using of a unique icon for allowing authorized access. Quite the contrary, shortcuts and links provided are not unique to any particular user. Accordingly, it could not teach or suggest the icon be created by a computer and stored in memory as taught and claimed by Applicant.

C. The rejection of claims 3, 5 and 6 under 35 USC § 103(a)

Claim 3 is dependent upon claim 1 and introduces the additional limitation that an electronic camera is used to create the electronic icon and automatically associated the electronic icon with the digital image captured by the camera. The additional cited reference to Tomat also fails to teach or suggest the unique icon associated with a user as taught and claimed by Applicant. The thumbnails of Tomat are just simply a low resolution image of the high resolution image and is associated therewith. The Tomat reference does not render anything which would render claim 1 obvious nor add anything with regard to creating the unique electronic icon as taught and claimed by Applicant. Claim 5 is dependent upon claim 3 and introduces the limitation that the electronic camera has a communication device for transferring the digital media file to a service provider wherein an electronic icon includes instructions for further processing of the digital image. An example for the processing could be the providing of a print and forwarding to a particular recipient. The Examiner refers to column 5, lines

42-50 and column 7, lines 7-15 for illustrating communication interface may be a modem or network adapter. However, there is no teaching or suggestion of providing a communication device or for transferring of the media file to a service provider that includes instructions for further processing as set forth in claim 5.

D. The rejection of claim 8 under 35 USC § 103(a)

The Examiner rejected claim 8 over Jalili, Savitzky, Tomat and further in view of Reed et al. In particular the Examiner cites that Reed teaches an invention for an automated communication system where instructions can contain information for automatically transmitting documents. The Examiner argues that it would have been obvious to combine this with Jalili to have information automatically transmitting documents because doing so would improve Jalili's invention by allowing user to easily establish a connection and simplify the process of transferring files. However, Jalili is directed primarily to providing a system to allow a user to securely enter data into a communication data network. There is no teaching or suggestion in Jalili as to why one would modify this to include instructions for automatically forwarding a digital image. Quite the contrary, Jalili is directed to providing security for limiting access to certain files. Applicant respectfully submits there is no motivation to make the proposed combination as the Reed reference is designed to allow other people to have access to the item whereas Jalili is directed to restricting access only to an authorized party.

E. The rejection of claims 11 and 12 under 35 USC § 103(a)

The Examiner cites that Jalili, Savitzky, Hoyle and Morris for teaching the invention set forth in claim 11. In particular, claim 11 is directed to a method for managing digital images by a service provider on a computer of a user over a communication network. The method includes creating an electronic icon containing information unique to the user that includes information for allowing controlled access by a designated third party to a particular digital media file stored on the computer, said service provider accessing the computer over a communication network and locating digital media file having the icon and

allowing access to the digital media file by the designated third party. In this regard the Examiner has had to rely on four separate and distinct references in order to arrive at Applicant's invention. The various references are all directed to various different problems and solutions. There is no motivation, teaching or suggestion as to why one would take individual components from any of these references and combine them in a manner taught and claimed by Applicant. As previously discussed, the Jalili and Savitzky references do not teach or suggest the creating of an electronic icon which contains information unique to the user that includes information for allowing controlled access by a designated third party to a particular digital media file stored on the computer. The Jalili reference is directed to providing a secure manner for entering passwords into a system by the use of icons that are suitably randomly positioned on a display screen. Thus, claim 11 is patentably distinct for the same reasons previously discussed with respect to claim 1. In addition, claim 11 includes the additional limitations that the service provider allows access to the digital media file by the designated third party based on the unique icon. Neither of the two additional references teach or suggest the use of an electronic icon unique to a user for controlling access to the media file. The fact that the Examiner has had to piecemeal four independent references in order to arrive at Applicant's claimed invention is an indication that the present invention is not obvious. There is no motivation, teaching or suggestion in any of the references cited to make the combination taught and claimed by Applicant. As previously discussed, the Jalili and Savitzky references are totally apart and distinct from each other and there is no teaching or suggestion of making the combination as there is no reason to do so. The Savitzky reference is directed to a system in which images downloaded from a camera are used to generate an HTML page or provide images to an existing HTML page that are accessible over a communication network. It is respectfully submitted that independent claim 11 is patentably distinct over the cited references.

The remaining claims depend at least ultimately upon the claims discussed above and are therefore patentably distinct for the same reasons.

Summary


In summary, Applicant respectfully submits that the present invention is patentably distinct over the cited prior art.

Conclusion

For the above reasons, Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1-15.

Respectfully submitted,

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Appendix I - Claims on Appeal

1. A system for managing digital images, comprising:
a device for creating an electronic icon containing information unique to a particular user including information allowing access with respect to a particular digital media file having said icon associated therewith over a communication network by a third party.
2. A system according to claim 1 wherein said device for creating said electronic icon comprises a user computer and said digital media file is stored in a memory device in said computer.
3. A system according to claim 1 wherein an electronic camera is used to create said electronic icon and automatically associates said electronic icon with digital image file captured by said electronic camera
4. A system according to claim 1 further comprising a communication device for transferring said digital media file from said user computer over said communication network.
5. A system according to claim 3 wherein said electric camera has a communication device for transferring said digital media file to a service provider wherein said electronic icon includes instructions for further processing of said digital image file.

6. A system according to claim 5 wherein said provider provides confirmation of receipt of said digital media file to said electronic camera.
7. A system according to claim 6 wherein said confirmation further includes confirmation of said instructions.
8. A system according to claim 5 wherein said instructions includes the automatically forwarding of said digital image file to a third party.
9. A system according to claim 2 wherein a service provider having access to said digital media file so as to obtain said icon and allow access in accordance with said information.
10. A system according to claim 5 wherein said communication device is a wireless phone.
11. A method for managing digital images by a service provider on a computer of a user over a communication network, comprising:
creating an electronic icon containing information unique to said user that includes information for allowing controlled access by a designated third party to a particular digital media file stored on said computer;

said service provider accessing said computer over said communication network and locating digital media files having said icon associated therewith and allowing access to said digital media files by said designated third party.

12. A method according to claim 11 wherein said information comprises instruction with respect to said digital image files

13. A method according to claim 12 wherein said instructions comprises forwarding said digital media file to said designated third party.

14. A method according to claim 13 wherein said instructions comprises forwarding the electronic address said digital media file to said designated third party such that said designated third party may directly access said digital media file.

15. A method according to claim 14 wherein said digital media file is a low resolution copy of a higher resolution media file.